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In re Application of
Hideo Sugimori
Application No. 10/690,584
Filed: October 23, 2003
For: OPERATIONS MANAGEMENT POLICY
DISTRIBUTING METHOD, OPERATIONS
MANAGEMENT POLICY DISTRIBUTING
APPARATUS, AND OPERATIONS
MANAGEMENT DISTRIBUTING PROGRAM

: DECISION ON THE PETITION
: REGARDING REQUEST TO
: WITHDRAW REQUIREMENT
: FOR RESTRICTION

Applicant's petition under 37 CFR 1.144, filed October 26, 2009, requests the supervisor to mandate that the examiner reinstate claim 11, withdrawn by original presentation in the Office action of August 19, 2008.

The petition is **GRANTED**.

A review of the file record indicates that in response to an amendment by the applicant filed August 19, 2008 which added claim 11, the examiner required restriction between the originally filed claims 1-10 and newly filed claim 11. Because the applicant had already received an examination on the merits of claims 1-10, the examiner indicated that this invention had been constructively elected by original presentation. In the restriction the examiner required restriction between Invention I (Claims 1-10) and Invention II (Claim 11) as subcombinations usable together.

On March 9, 2009, the applicant argued that the restriction was improper, that the constructive election was improper and that claim 11 should be examined with claims 1-10. The examiner was not persuaded, and in the Office action of July 24, 2009 made the requirement for restriction final, indicating that "...Claim 11 has separate utility such as the manager is provided with a policy rating based upon a number of clients (now amended as "computers") operating under the corresponding policy, overall operation time of the corresponding policy among the plurality of clients (now amended as "computers") , and a number of applications running on the client (now amended as "computers") to be managed, and does not require the sending back the created policy list to a manager as required in subcombination I...".

The applicant filed the instant petition which argues that the above-noted inventions are not considered independent because they are not "unconnected in design, operation and effect". Applicant also argues that the claims are not distinct because "...both claim 1 and claim 11 are related to a manager managing a network of computers and the manager's selection of a management selection which is to be sent to a computer to be managed. Claim 11 simply contains an additional limitation that is not found in claim 1, which is similar to the claim limitation found in dependent claim 4..."

Initially, looking at the original restriction of August 19, 2008, it is noted that in order for two inventions to be restricted as subcombinations usable together, they are usually only restrictable "when the subcombinations do not overlap in scope and are not obvious variants". Also, "restriction is only proper when there would be a serious burden if restriction were not required, as evidenced by separate classification, status or field of search". MPEP 806.05(d).

In this case, it is clear that the inventions of claim 1 and claim 11 fail to qualify as not overlapping in scope, as the majority of method steps recited in claim 11 are identical, (or substantially so) to those recited in claim 1. Furthermore, the limitations in claim 11 that are not present in claim 1 appear to be similar to those existing in claim 4. The examiner, in the original restriction, listed five possible reasons as to why there may be a serious burden if restriction was not required, however, never indicated which of these reasons applied to these inventions, and specifically how they might apply.

Given the above facts, the inventions of claims 1-10 and claim 11 are not seen as properly defined as subcombinations usable together, and have not been shown to be distinct so as to be able to support separate patents. Furthermore, no sufficient showing of serious burden has been demonstrated by the examiner.

This application is being returned to the examiner to issue a new non-final Office action that includes an examination on the merits of all pending claims 1-11, consistent with this decision.

The petition of October 26, 2009 is GRANTED.

Any questions or comments with respect to this decision should be forwarded to Quality Assurance Specialist Steven N. Meyers at (571) 272-6611.



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